Opinion of United States Court of Appeals for the Second Circuit.

UNITED STATES COURT OF APPEALS

FOR THE SECOND CIRCUIT

No. 171—September Term, 1968.

(Argued November 12, 1968 Decided January 13, 1969.)

Docket No. 32602

JOHN K. RAINS,

Plaintiff-Appellant,

—against—

NIAQUA, INC.,

Defendant-Appellee.

Before:

FRIENDLY, SMITH and FEINBERG,

Circuit Judges.

Appeal from judgment for defendant in patent infringement case after trial before John O. Henderson, *C. J.*, United States District Court for the Western District of New York. Affirmed.

Opinion of United States Court of Appeals for the Second Circuit.

LEON J. GREENSPAN, White Plains, N. Y. (Greenspan & Aurnou, on the brief), *for Plaintiff-Appellant.*

EDWIN T. BEAN, Buffalo, N. Y. (Bean, Brooks, Buckley & Bean, on the brief), *for Defendant-Appellee.*

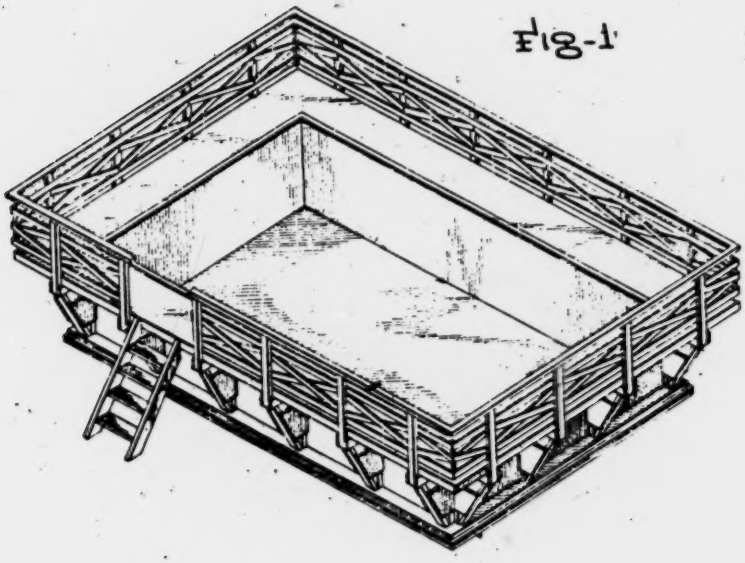
FEINBERG, *Circuit Judge:*

Plaintiff John K. Rains appeals from an adverse judgment in his patent infringement action against defendant Niaqua, Inc. after a trial before Chief Judge John O. Henderson in the United States District Court for the Western District of New York. Plaintiff is the owner of design patent No. Des. 201,793 for a swimming pool. Chief Judge Henderson held the patent invalid and not infringed. Because we believe that the former conclusion was not erroneous, we affirm.

I.

The design patent in suit was applied for in April 1963, and issued in August 1965. It deals with the appearance of an above ground, as distinguished from an inground or excavated, swimming pool. In practice, pools utilizing plaintiff's design have been made from redwood with a vinyl liner holding the water. Plaintiff's design is simple and attractive; most probably the latter quality is due to the former. The patent itself merely claims the "ornamental design for a swimming pool, as shown and described" in twelve accompanying figures. Figure 1 of the patent is as follows:

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As indicated, the design shows a rectangular structure apparently resting on a smaller rectangle. Around the top of the pool is a deck or walkway supported by vertical studs, which also help to support the sides of the pool, and by diagonal or inclined struts extending between the outer edge of the deck and the base of the pool. The vertical studs and inclined struts come together at and rest on the extended base, and together with the bottom of the deck they form inverted right triangles that appear at even intervals around the pool. The studs and struts are connected by plywood panels (gussets), which close most of

the triangular space between them. A ladder along one of the sides provides access to the deck. And finally, the entire deck is enclosed by a fence made from crisscross slats and vertical posts.

With a design patent it is the appeal to the eye—the appearance of the design—that is crucial. See *Vacheron & Constantin-Le Coultre Watches, Inc.* v. *Benrus Watch Co.*, 260 F. 2d 637, 641 (2d Cir. 1958). Nevertheless, design patents are generally governed by the same principles that apply to other patents. See, e.g., *Hygienic Specialties Co.* v. *H. G. Salzman, Inc.*, 302 F. 2d 614 (2d Cir. 1962); *Blisscraft of Hollywood* v. *United Plastics Co.*, 294 F. 2d 694 (2d Cir. 1961). Thus, 35 U. S. C. § 171 states:

> Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.
>
> The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

Under this section, a patentable design must be both ornamental and novel, the latter a requirement that it meet the general standards of novelty of 35 U. S. C. § 102. Similarly applicable to design as well as other patents is the command of 35 U. S. C. § 103:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which

said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Plaintiff claims that his swimming pool design meets the statutory requirements of ornamentality, novelty, and non-obviousness. He argues that his design is unique in several respects, discussed below, that it met a long felt need in the industry and consequently has enjoyed considerable commercial success, and that defendant failed to offer evidence sufficient to overcome the presumption of 35 U. S. C. § 282 that the patent is valid.[1]

II.

The district court held that plaintiff's design patent was invalid under section 103;[2] in the light of the existing prior art, the court found that the design would have been obvious to a person having ordinary skill in the relevant art. The prior art relied upon by the district court and argued here most strongly by defendant was introduced in the course of cross-examination by plaintiff. It includes a photograph of a swimming pool, two United States design patents, and a French patent.

The photograph is of a pool known in the trade as the "Esther Williams" pool, which apparently was the first above ground redwood-type swimming pool to be widely marketed in this country. The photograph reveals an above

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[1] Section 282 provides in part:

"A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on the party asserting it."

[2] The district court also found that the design was not ornamental. We do not reach the question.

ground swimming pool with an elevated deck and a vertical fence. The fence posts, however, rather than ending at the deck extend to the ground and serve to help support the deck. Moreover, the space between the posts is enclosed by a redwood weave, and thus the sides of the pool are not visible.

Both of the design patents were issued to Donald A. Preuss. The first, No. Des. 185,570 issued in 1959, is for a pool similar to the Esther Williams pool—a rectangular pool with a deck surrounded by a vertical fence that begins at ground level and hides the deck supports and pool sides. The second Preuss design patent, No. Des. 189,811 issued in 1961, is on what is known as the "Futura" pool. Unlike the two pools just described, the sides of the Futura pool and its deck supports are clearly exposed. The Futura does not have a crisscross fence or gussets; otherwise, the chief difference between it and plaintiff's pool design is that the Futura fence is inclined, the struts merely being extended to form the fence posts, while in plaintiff's design, the fence posts are separate from the struts and extend vertically above the deck.

The French patent, No. 768,506 issued in 1934, is a mechanical patent for a portable onground swimming pool made out of metal. The patent describes at length the technique of construction but does include four drawings similar to the type of figures incorporated in plaintiff's patent—a lateral view, an overhead view, a cross-sectional view, and an enlarged partial cross-sectional view—showing an inverted triangular deck support and a vertical fence rising above the deck.

Plaintiff claims that this evidence of prior art alone was not enough to support a finding in defendant's favor. Plaintiff argues that the stautory presumption of validity must prevail because defendant did not introduce expert

testimony on the obviousness of plaintiff's design. That, however, misconstrues the effect of the presumption: It has no independent evidentiary value; rather, it serves to place the burden of proof on the person who asserts invalidity. Reasonable doubt on the issue of validity must be resolved in favor of the patent holder, but in the usual case a preponderance of the evidence determines the issue. See *Lorenz* v. *F. W. Woolworth Co.*, 305 F. 2d 102, 105 (2d Cir. 1962). Thus, plaintiff's argument that defendant must lose because it was content to rest after plaintiff had presented his case is without merit.[3] The evidence relied on by defendant—the prior art—was already admitted, and this court has even held that in a proper case a defendant may successfully move for summary judgment on prior art alone. See *Monaplastics, Inc.* v. *Caldor, Inc.*, 378 F. 2d 20 (2d Cir. 1967). In this case, of course, there was a plenary trial before Chief Judge Henderson.[4]

III.

We now turn to the district court's conclusion that in view of the prior art plaintiff's design was obvious. Plaintiff appears to rely on the following three features of his pool: (1) the effect of a greater rectangular box over a smaller rectangular box with (2) the impression of an inclined strut coming up beneath the deck and (3) a separate vertical fence post that does not extend completely to the ground. According to plaintiff, these features create

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[3] Judge Henderson found that plaintiff's witnesses on nonobviousness were unconvincing, primarily because they did not demonstrate familiarity with all of the prior art. Cf. *Formal Fashions, Inc.* v. *Braiman Bows, Inc.*, 369 F. 2d 536, 539 (2d Cir. 1966).

[4] The trial lasted three days, involved 10 witnesses, and produced 329 pages of transcript.

"a startling use of symmetry" and "an ornamental and novel silhouette," and were nonobvious in the light of the prior art.[5]

In comparing plaintiff's design with prior art, we are aided by the guide laid down by the Supreme Court in *Graham* v. *John Deere Co.*, 383 U. S. 1, 17 (1966):

> While the ultimate question of patent validity is one of law [citing A. & P. Tea Co. v. Supermarket Equip. Corp., 340 U. S. 147, 155 (1950)], the § 103 condition, which is but one of three conditions, each of which must be satisfied, lends itself to several basic factual inquiries. Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or non-obviousness of the subject matter is determined.

The question before us is whether the trial judge was wrong in concluding that plaintiff's design would have been obvious under section 103 to "the ordinary designer who is chargeable with knowledge of the prior art." *General Time Instruments Corp.* v. *United States Time Corp.*, 165 F. 2d 853, 854 (2d Cir.), cert. denied, 334 U. S. 846 (1948); see, e.g., *Blisscraft of Hollywood* v. *United Plas-*

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[5] Plaintiff's patent would also seem to encompass three other features: (4) the gussets, (5) a crisscross fence, and (6) stairs leading from the ground to the deck. These, however, are not urged here as establishing nonobviousness; probably because (4) is not used in defendant's pool, and (5) and (6) are revealed by the prior art; e.g., the former is clearly shown in an illustration from *Popular Mechanics*, also relied upon by defendant as prior art.

tics Co., supra, 294 F. 2d at 696. The entire concept of obviousness is, no doubt, "an elusive one, especially when applied to elements of design." *Hygienic Specialties Co.* v. *H. G. Salzman, Inc., supra,* 302 F. 2d at 618. However, we are not convinced that Judge Henderson erred in holding that plaintiff's design does not meet the statutory standard. It would not seem to be a great feat for a designer of average ability to combine features (1), (2), and (3), which are disclosed in the pools described above. The Esther Williams type pool made use of two rectangular boxes and a vertical fence, though the smaller box was not as visible as it is in plaintiff's design and the fence extended to the ground. The Futura design can be described as a greater box resting on a smaller box and made use of inclined struts for deck supports. Finally, the French swimming pool patent utilized inverted triangles coming up under the deck for support and had vertical fence posts that did not extend completely to the ground.

We are buttressed in this view by the instruction of the Supreme Court "to scrutinize combination patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements." *A. & P. Tea Co.* v. *Supermarket Equip. Corp.,* 340 U. S. 147, 152 (1950). Indeed the standards are, if anything, stricter for combinations of design elements. See *Vacheron & Constantin-Le Coultre Watches, Inc.* v. *Benrus Watch Co.,* 269 F. 2d 637, 642 (2d Cir. 1958) (dissenting opinion). At the same time, we are mindful that a combination of elements that seems simple in retrospect may not have been so simple at the time it was first produced. But here, when the very similar features of the French patent—the cross-sectional drawing there and the cross-sectional figure in-

cluded in plaintiff's patent are, as plaintiff admitted at trial, virtually identical—are considered, plaintiff's design is seen to be a mere adaptation of those features to the similar redwood type pools of the prior art.[6] Accordingly, the trial judge justifiably concluded that plaintiff's design would have been obvious to a designer of ordinary skill at the time plaintiff set out to design a new attractive pool.[7]

Plaintiff claims that the evidence of long felt need in the industry for his design and the considerable commercial success enjoyed by plaintiff's franchise holders and the "infringing imitators" establish that his design could not have been obvious. The evidence is not so clear as plaintiff claims, however, as there was evidence that all types of above ground swimming pools, including competing designs, were enjoying greatly increasing sales so that social and economic factors may have been a major reason for

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[6] Plaintiff argues that defendant's reliance upon the French patent is improper because of differences between it and plaintiff's design; e.g., unlike the latter, the bottom and sides of the pool described in the French patent form "a U-shaped profile and the inclined supports are panels or shutters that hide the sides of the pool. Nevertheless, we think that the description and drawings of the French patent—even with these differences—would be both very important to and readily usable by a skilled designer familiar with the other prior art.

[7] Many observers have noted the strict standards of patentability that must be met before the long term monopoly protection of a patent is awarded a design and have suggested that lesser protection be granted the nonpatentable but novel design. See, e.g., *Alfred Bell & Co.* v. *Catalda Fine Arts, Inc.*, 191 F. 2d 99, 104 (2d Cir. 1951); Note, Protection for the Artistic Aspects of Articles of Utility, 72 Harv. L. Rev. 1520 (1959); Note, Design Protection—Time to Replace the Design Patent, 51 Minn. L. Rev. 942 (1967), discussing *In re Laverne*, 53 C.C.P.A. (Patents) 1158, 356 F. 2d 1003 (1966).

commercial success.[8] Moreover, such evidence is at best secondary in determining the obviousness of an invention. See *Graham* v. *John Deere Co., supra,* 383 U. S. at 17-18. This court has repeatedly said that commercial success cannot establish patentability when the evidence of obviousness is strong. See, e.g., *Continental Can Co.* v. *Old Dominion Box Co.,* 393 F. 2d 321, 326 (2d Cir, 1968). The same is true with regard to evidence of a long felt need in the industry.

Plaintiff also cites testimony that the use of a vertical fence that did not extend to the ground presented structural problems to be solved. Similarly, plaintiff testified that most people would consider the inverted triangular stud and strut supportless stable than alternative methods of support. From this, plaintiff argues that, like the inventor in *United States* v. *Adams,* 383 U. S. 39 (1966), he had to ignore disadvantages in designing his pool. However, there is nothing to suggest that these problems were partciularly difficult to solve or that they would have been a deterrent to a designer of ordinary skill familiar with the prior art.

Finally, plaintiff points to a recent decision of the Third Circuit, which overruled a trial court finding that plaintiff's patent is invalid. *Rains* v. *Cascade Indus., Inc.,* 402 F. 2d 241 (3d Cir. 1968) (2-1). In that case, the Third

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[8] That was the conclusion reached by the trial judge:

"The plaintiff has produced witnesses to testify with respect to the public acceptance and commercial success of his franchised pool and witnesses who testified that they preferred the appearance of plaintiff's pool to other pools on the market. The testimony of plaintiff's franchise holders shows public acceptance of above ground pools of all types. The pools of plaintiff's design, with substantial sums for advertising, have enjoyed considerable success. Much of that success, however, would appear attributable to changing social and economic factors."

Circuit held that the existence of factual issues made the lower court grant of summary judgment inappropriate,[9] while here there has been a judgment after trial. Therefore, *Cascade* on that basis is technically distinguishable—but only barely—and we would not regard that as an adequate response to plaintiff's reliance on the decision. Of more substance as a distinction, however, are the presence in this record of plaintiff's admissions of similarity between the French patent and his design and the emphasis placed in *Cascade* on the gussets in plaintiff's design, a feature neither used by defendant here nor emphasized by plaintiff to us. In any event, as is clear already, we would agree with the trial judge in *Cascade* and the dissenting member of the court of appeals panel.

In sum, for the reasons set forth above, it was not error for the trial court to conclude that plaintiff's design was obvious in the light of the prior art. It is not necessary for us to consider the district court's conclusion that, even if valid, the patent was not infringed. The judgment of the district court is affirmed.

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[9] A similar conclusion was reached by Judge Sugarman in still another suit by plaintiff. *Rains* v. *Monarch Pool Corp.*, No. 65 Civ. 2531 (S. D. N. Y., June 1, 1966). That case has not yet come to trial.

Opinion of United States District Court (Henderson, J.).

UNITED STATES DISTRICT COURT,

WESTERN DISTRICT OF NEW YORK.

CIVIL 11568

JOHN K. RAINS,

Plaintiff,

v.

NIAQUA, INC.,

Defendant.

GREENSPAN & AURNOU (LEON J. GREENSPAN, Esq., of Counsel), White Plains, New York; and Sommer & Weber (Kenneth R. Sommer, Esq., of Counsel), Buffalo, New York; Attorneys for Plaintiff.

BEAN, BROOKS, BUCKLEY & BEAN (Edwin T. Bean, Esq., of Counsel); and Jaeckle, Fleischmann, Kelly, Swart & Augspurger (John M. Montfort, Esq., of Counsel); Buffalo, New York, Attorneys for Defendant.

This is an action brought under the patent laws of the United States for alleged infringement by defendant of Patent No. Des. 201,793. Jurisdiction and venue are not disputed.

The plaintiff, John K. Rains, is a resident of White Plains, New York, and the owner of the patent in suit which was applied for on April 26, 1963, and issued on August 3, 1965. Niaqua, Inc., the defendant, is a New York corporation having its principal place of business within this district.

Opinion of United States District Court (Henderson, J.).

The patent is directed to the appearance of an above ground or on ground, as distinguished from an excavated swimming pool. Depicted in the patent is a rectangular pool, the elevated rim of which is surrounded by a walkway reached by stairs. The walkway is safeguarded by a crisscross splat type fence which is perpendicular to the walkway and ground. For support, the walkway, in part, utilizes a series of equally spaced vertical posts or studs which also support the walls of the pool. Two horizontal members, an inclined strut and gussets are joined with each of the posts or studs so as to form a series of inverted, partially enclosed triangles which fully support the walkway above and add to the lateral integrity of the posts or studs.

The pool marketed by the defendant initially was more similar in general appearance to the plaintiff's design, omitting only the aforementioned gussets through substitution of heavier posts or studs. Following notice of the issuance of the plaintiff's patent, the defendant discontinued use of the crisscross splat type fence.

In defense of the suit, the defendant claims invalidity and noninfringement.

With respect to the issue of validity, the prior art has been asserted and is pertinent. The so-called Esther Williams pool, concededly prior, is rectangular, has the elevated walkway, and uses a perpendicular fence. The fence line, however, is carried downward to ground level and enclosed to conceal the actual tank area. The patent to Pruess, Des. 185,570, issued in 1959, discloses features similar to the Esther Williams pool.

The patent to Pruess, Des. 189,811, issued in 1961, is most relevant since it employs a series of inverted triangular forms emanating from the pool tank, as does the patent in suit. The fence line, however, is also inclined

to complement the inclined aspect of the substructure. The French patent, No. 768, 506, issued in 1934, although a mechanical patent, displays overall features quite similar to the patent in suit.

Popular Mechanics Magazine of April 1961, at page 162 in the upper left-hand column, second figure from the top, shows a design for a fence or railing using crisscross splats that could be used in any suitable environment.

The plaintiff has produced witnesses to testify with respect to the public acceptance and commercial success of his franchised pool and witnesses who testified that they preferred the appearance of plaintiff's pool to other pools on the market. The testimony of plaintiff's franchise holders shows public acceptance of above ground pools of all types. The pools of plaintiff's design, with substantial sums for advertising, have enjoyed considerable success. Much of that success, however, would appear attributable to changing social and economic factors.

Title 35 § 103 U.S.C. provides:

> "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

In this court's judgment, the failure of those witnesses who testified on the issue of obviousness to demonstrate sufficient familiarity with the prior art, renders their opinions of little value.

Opinion of United States District Court (Henderson, J.).

Two decisions have been rendered in connection with the Rains patent. One by Judge Sugarman in the Southern District of New York, apparently unreported, denied defendant's motion for summary judgment on the issue of validity. In so ruling, Judge Sugarman appears to have been principally impressed by the decorative aspects of the gusset plates employed on plaintiff's design. District Judge Wortendyke of the District of New Jersey, on motions for summary judgment,[1] declared the Rains patent invalid.[2] This court finds little to add to Judge Wortendyke's excellent analysis of the legal principles involved or to his discussion of the references cited by the patent office.

On a full trial record, this court joins in Judge Wortendyke's view that:

> "The design of the patent in suit utilizes in combination a number of elements which severally were well known to the prior art. The utilization of these old elements in combination does not represent inventive skill and creative talent beyond that of the ordinary designer chargeable with knowledge of the prior art. What the plaintiff here has done amounts to nothing more than 'an unstartling regrouping of old elements which demonstrated no originality born of inventive faculty.' (Bliss, supra, 316 F. 2d at p. 850). If it be assumed that plaintiff's design discloses the talent of an adapter, nevertheless it fails to manifest the art of the inventor. Moreover, the design is not ornamental in the sense that it is the product of aesthetic skill and

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[1] The plaintiff denies that that case was in a proper posture for summary judgment.

[2] *Rains* v. *Cascade Industries, Inc.*, 269 F. Supp. 688 (D.C.N.J. 1967).

artistic conception. It has no particularly aesthetic appeal, in line, form, color, or otherwise. It contains no dominant artistic motif either in detail or in its overall conception.'"[3]

Concluding that the patent in suit is invalid, the issue of infringement need not be reached. However, were the court not convinced of the invalidity of the patent, it would not find infringement. Plaintiff's design, with the possible exception of the gussets, is readily suggested by reference to the prior art. A view of validity, therefore, would appear to require a finding that use of the gussets would in no way be suggested or occur to an adapter. Since defendant's pool has never utilized gussets, the court would not find infringement.

Let judgment enter accordingly.

/s/ John O. Henderson
JOHN O. HENDERSON
United States District Judge

DATED: March 25, 1968.

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[3] *Rains* v. *Cascade Industries, Inc.*, 269 F. Supp. 688, 695 (1967).

Opinion of United States Court of Appeals for the Third Circuit.

UNITED STATES COURT OF APPEALS

FOR THE THIRD CIRCUIT

No. 16957

JOHN K. RAINS

Appellant,

v.

CASCADE INDUSTRIES, INC.

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE DISTRICT OF NEW JERSEY

Argued March 18, 1968

Before McLAUGHLIN, FORMAN and FREEDMAN, *Circuit Judges.*

OPINION OF THE COURT

(Filed October 14, 1968)

FREEDMAN, *Circuit Judge.*

This appeal involves the validity of a design patent for an on-the-ground swimming pool.[1]

Plaintiff, the holder of the patent, alleged infringement by defendant and sought damages and an injunction. Defendant counterclaimed for a declaratory judgment of in-

[1] United States Design Patent No. 201,793 issued August 3, 1965.

validity or of noninfringement and sought damages and injunctive relief. The district court granted defendant's motion for summary judgment, declared the patent invalid and entered judgment for the defendant. 269 F.Supp. 688 (D.C.N.J. 1967).[2]

Although the district court did not dispose of defendant's counterclaim for damages and injunctive relief and made no certification of appealability under Rule 54(b) of the Federal Rules of Civil Procedure, its judgment of invalidity denied plaintiff the injunctive relief which he sought and is therefore appealable under 28 U.S.C. 1292(a)(1) as an order refusing an injunction.[3]

Plaintiff's patent consists simply of various views of an on-the-ground pool. The basic design depicts a rectangular tank with vertical sides. A base extending slightly outward surrounds entirely the bottom of the tank. The top of the tank is surrounded on all four sides by a horizontal deck which is enclosed by a vertical crisscross fence. A ladder at the middle of one of the long sides of the pool

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[2] Plaintiff's design has been the subject of a number of lawsuits. In Rains v. Monarch Pool Corp., et al., an unreported decision in the District Court for the Southern District of New York (65 Civ. 2531), Judge Sugarman denied defendant's motion for summary judgment. That case apparently still remains pending. In Rains v. Niaqua, Inc., Judge Henderson of the District Court for the Western District of New York after a full trial entered judgment for defendant (Civil Action No. 11568, as yet unreported), largely relying upon the opinion of Judge Wortendyke in this case. That case is now pending on appeal in the United States Court of Appeals for the Second Circuit. A number of other actions are pending in the District Courts of New Jersey and the Southern District of New York.

[3] Hook & Miller v. Hook & Ackerman, Inc., 233 F.2d 180, 181-83 (3 Cir. 1956), cert. denied, 352 U. S. 960 (1957); cf. Newburgh Moire Co., Inc. v. Superior Moire Co., Inc., 218 F.2d 580 (3 Cir. 1955). See also George P. Converse & Co., Inc. v. Polaroid Corp., 242 F.2d 116, 119-20 (5 Cir. 1957); Cutting Room Appliances Corp. v. Empire Cutting Machine Co., Inc., 186 F.2d 997 (2 Cir. 1951).

provides access to the deck. Struts placed at regular intervals around the entire pool extend diagonally from the base of the tank to a point slightly short of the outer edge of the bottom of the deck. At the same intervals studs are attached to the side of the tank for support. The struts, studs and deck form an open triangle which is covered by gussets which fill the open triangle except for a small space at its top and bottom.

A variation in the patent design depicts a wider deck at one end of the pool and vertical supporting posts reaching to the ground. Another variation is a larger version of the first design, with additional struts, studs and gussets.

In moving for summary judgment the defendant relied on a number of exhibits containing prior art. It is necessary only to review that portion of the prior art which is closest to plaintiff's design. A drawing for French Patent No. 768,506, a mechanical patent, issued in May, 1934, was submitted without verbal description of the patent itself. The drawing discloses an on-the-ground pool with what appears to be a rectangular tank, a deck extending horizontally from the long sides of the top of the tank, with struts similar to plaintiff's, but with no gussets. A vertical fence which is not, however, crisscross in type, encloses the two decks. A ladder extends from the end of the deck to the ground.[4]

A design patent issued to Donald Pruess in 1961[5] shows a square on-the-ground tank with a deck similar to plaintiff's which surrounds the pool. The fence, however, is not crisscross and is inclined outward from the deck, sup-

[4] Plaintiff filed an affidavit claiming that the verbal patent description shows that the sides of the tank are curved and its overall shape is that of a U. The diagram in the patent does not show both ends or both sides of the pool.

[5] U. S. Design Patent No. Des. 189,811, issued February 28, 1961.

ported by struts extending from the top of the fence diagonally down to the base of the tank. There are no gussets. The pool has a modernistic flair and is marketed as the "Futura" by International Swimming Pool Corp.

Other previously patented on-the-ground pools have decks supported by vertical posts rather than diagonal struts. Defendant also presented a number of mechanical patents for window scaffolds and brackets, designed to provide strength and having the general triangular shape of the strut-gusset arrangement. Pictures of a crisscross fence like plaintiff's in *Popular Mechanics* were also presented.

On the basis of the prior art the district judge granted summary judgment for the defendant. Such a judgment is appropriate, under Rule 56 of the Federal Rules of Civil Procedure,[6] in patent cases as in other civil actions where there is no genuine issue of material fact. In such cases, however, we begin with the statutory presumption of the validity of a patent and the consequent requirement that the burden of establishing its invalidity rests on the party who asserts it.[7]

In seeking to sustain the summary judgment in its favor defendant argues that it was proper because each party had filed a cross-motion for summary judgment. Although plaintiff filed no such motion the opinion of the district judge assumed from remarks in plaintiff's brief

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[6] Methode Electronics, Inc. v. Elco Corp., 385 F.2d 138, 141 (3 Cir. 1967); Allen-Bradley Co. v. Air Reduction Co., Inc., 391 F.2d 282 (3 Cir. 1968).

[7] Section 282 of the Patent Act of 1952 provides in part as follows:

> "A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it." (35 U.S.C. § 282).

that he, too, sought summary judgment. But even if these remarks could be deemed the equivalent of a cross-motion by plaintiff for summary judgment,[8] it would not serve to avoid a consideration of the correctness of the entry of summary judgment. Cross-motions are no more than a claim by each side that it alone is entitled to summary judgment, and the making of such inherently contradictory claims does not constitute an agreement that if one is rejected the other is necessarily justified or that the losing party waives judicial consideration and determination whether genuine issues of material fact exist. If any such issue exists it must be disposed of by a plenary trial and not on summary judgment. *F.A.R. Liquidating Corp.* v. *Brownell,* 209 F. 2d 375, 380 (3 Cir. 1954).

[8] See Rules 7(b) and 56, Federal Rules of Civil Procedure.

We turn then to the merits.

The district judge granted summary judgment for the defendant on two grounds: (1) Plaintiff's design was obvious in the light of the prior art because what he had done disclosed at best the talent of an adaptor, but not the art of an inventor. "The design as a whole", said the district judge, "would be obvious to a carpenter of ordinary skill familiar with the prior art." (2) The design was not ornamental and was not the product of aesthetic skill and artistic conception and had "no particularly aesthetic appeal in line, form, color or otherwise."

Section 171 of the Patent Act of 1952 provides:

> "Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.
>
> "The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided." (35 U.S.C. § 171).

We have held that in order to be patentable a design must be new, original, ornamental and non-obvious to a person of ordinary skill in the art. R. M. Palmer Co. v. Ludens, Inc., 236 F. 2d 496, 500 (3 Cir. 1956).[9]

The standard of non-obviousness under § 103, which the district judge held that plaintiff did not meet, includes the previously developed standard of invention,[10] often used synonymously with originality.[11] In Graham v. John Deere Co. of Kansas City, 383 U. S. 1, 17-18 (1966), the Supreme Court said: "[T]he § 103 condition, [non-obviousness] . . . lends itself to several basic factual inquiries. Under § 103, the scope and content of prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. . . . Such secondary considerations as commerical success, long felt but unsolved needs,

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[9] Section 103 of the Patent Act of 1952 provides:

"A patent may not be obtained though the invention is not identically disclosed or described . . . [by the prior art,] if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. . . ." (35 U.S.C. § 103)

[10] Graham v. John Deere Co. of Kansas City, 383 U. S. 1, 13-16 (1966).

[11] See Smith v. Whitman Saddle Co., 148 U. S. 674, 679 (1893); Krem-Ko Co. v. R. J. Miller & Sons, Inc., 68 F.2d 872, 873 (2 Cir. 1934).

Originality is also used to refer to the requirement of § 102(f) that no patent shall issue if the prospective patentee "did not himself invent the subject matter sought to be patented. . . ." (35 U.S.C. § 102(f)). See Note. Design Protcetion—Time to Replace the Design Patent, 51 Minn. L. Rev. 942, 948 (1967). Defendant does not dispute the existence of originality in this sense.

failure of others, etc. might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or non-obviousness, these inquiries may have relevancy."

The prior art shows that plaintiff's design at least differed from it in utilizing the gussets and combining them with the separate vertical fence and surrounding the entire pool with the deck and fence to create the effect of a large rectangle over a smaller rectangle. This design is not identical with the prior art and indeed defendant does not seriously contend otherwise.

On the standard of skill in the art, defendant offered no evidence, expert or otherwise. Plaintiff, however, in opposition to the motion for summary judgment offered affidavits and depositions on this subject. An affidavit of Henry S. Fishler, whose application for a patent was held by the Patent Office to constitute an interference with plaintiff's patent application, averred that at the time he made his patent application, International Swimming Pool Corp., his employer, was the dominant corporation in the on-the-ground swimming pool industry and that when International first learned of plaintiff's design it recognized that it was new, original, attractively ornamental and non-obvious not only to persons of ordinary skill in this field, but even to those possessing very considerable skill in the art. Fischler attested to his agreement with this judgment. He averred that because of its high opinion of plaintiff's design International directed him to prepare an application as close to it as possible. Fischler had had eleven years of continuous experience in the on-the-ground swimming pool industry and had worked for a number of manufacturers of such pools. The designs marketed by plaintiff and those who have substantially copied his design account, according to Fischler's affidavit, for approximately ninety per cent of

the on-the-ground swimming pool sales in the United States. Plaintiff's company is now dominant in sales and popularity in the industry, which Fischler described as highly competitive. This success he said was not due to superior advertising or marketing, since plaintiff's competitors have also done this, but without the same success. Nor was it due, according to Fischler, to a generally expanding market. Plaintiff's design, Fischler averred, had been copied or imitated innumerable times by competitors, and defendant itself, a former supplier for plaintiff's pool, deliberately copied it.[12]

While some of these allegations state ultimate conclusions of law, they are entwined with allegations of fact which show that the level of skill required to produce plaintiff's design reaches beyond the minimum necessary for a patent and that his pool has had a remarkably great acceptance by the public. Evidence of facts establishing the level of skill in an industry necessarily are often cast in language similar to the ultimate conclusion of law, but the evidence is not to be disregarded on this account,[13] and while commercial success alone is not enough to render an

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[12] In addition, Donald Pruess, the holder of the Prues patent, in an affidavit averred: "Mr. Rains' pool has a substantially different appearance from my own designs. . . . I know that customers are able to tell these pools apart by their appearance and that the appearance of Mr. Rains' pool has contributed substantially to its successful marketing.

"In my opinion Mr. Rains' design as shown in the patent was new, original, ornamental and certainly non-obvious to a person of ordinary skill in the art at the time Mr. Rains invented it."

[13] See Sperti Products, Inc. v. The Coca-Cola Co., —— F.2d —— (3 Cir. 1968).

article necessarily patentable, it is relevant evidence of non-obviousness.[14]

With these affidavits before the court we find it impossible to say that there is no factual determination to be made regarding the level of skill in the art. We cannot say that it is clear to us as laymen from a mere visual inspection and from the prior art that plaintiff's design was obvious to a person of ordinary skill in the art.[15] In determining whether summary judgment should be granted judges may not leap beyond the boundaries marked by experts and declare as laymen in the art that a new article or design is either obvious or non-obvious. As L. Hand, J., remarked: "Courts, made up of laymen as they must be, are likely either to underrate, or to overrate the difficulties in making new and profitable discoveries in fields with which they cannot be familiar. . . ."[16]

It therefore was error to enter summary judgment for the defendant on the issue of obviousness.

The district court also erred in holding on summary judgment that plaintiff's design was not ornamental. To be ornamental the configuration must be designed for aesthetic appeal rather than dictated primarily by functional requirements,[17] and the design as a whole must pre-

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[14] Graham v. John Deere Co. of Kansas City, supra at 17-18; Frank W. Egan & Co. v. Modern Plastic Machinery Corp., 387 F.2d 319, 324 (3 Cir.), cert. denied, —— U. S. —— (1968); Jones Knitting Corp. v. Morgan, 361 F.2d 451, 458 (3 Cir. 1966).

[15] Cf. Allen-Bradley Co. v. Air Reduction Co. Inc., 391 F.2d 282 (3 Cir. 1968).

[16] Safety Car Heating & Lighting Co., Inc. v. General Electric Co., 155 F.2d 937, 939 (2 Cir. 1946).

[17] Methode Electronics, Inc. v. Elco Corp., supra, n.6.

duce a pleasing impression on the aesthetic sense[18] of the ordinary observer.[19]

The district court did not question that plaintiff designed the pool for aesthetic appeal, but it held that the design did not have aesthetic quality. Our examination of the design of plaintiff's pool leads us to the conclusion that it cannot be said as an indisputable statement of fact that the design is not pleasing to the ordinary observer, especially when this is considered together with the evidence of its wide popularity and commercial success.[20]

Defendant seeks to overcome this conclusion by the contention that the gussets were designed to provide support for the deck and walls of the tank rather than for ornamental purposes. Plaintiff disputes this contention and points to other methods of support which would have been of greater structural value as showing that their use was dictated by ornamental considerations. Moreover, in the prior art no gussets were used for support. Since neither party has offered any facts to resolve their dispute on this question it must await determination at trial.

Finally, defendant contends that even if the district court was in error in granting summary judgment for lack of non-obviousness and lack of ornamental quality, the judgment nevertheless should be sustained because plaintiff's patent lacked novelty. The standard of novelty is

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[18] R. M. Palmer Co. v. Luden's, Inc., supra at 500-1.

[19] See J. R. Wood & Sons, Inc. v. Abelson's, Inc., 74 F.2d 895, 896 (3 Cir. 1934); Boyle v. Rousso, 16 F.2d 666, 668 (8 Cir. 1926). In re Schraustadter, 26 App. Div. D.C. 331 (1905); In re Rutledge, 47 F.2d 797 (C.C.P.A. 1931). See also Gorham Co. v. White, 81 U.S. 511, 527-28 (1871).

[20] See Jacob Elishewitz & Sons Co., Inc. v. Bronston Brothers & Co., Inc., 40 F.2d 434 (2 Cir. 1930).

whether the design appears to the ordinary observer to differ from the prior art and not to be a mere modification of it.[21] Here, too, their exists a question of fact,[22] for it is not obvious from a comparison of plaintiff's design with the prior art that plaintiff's design was not novel, especially when this is considered along with the evidence of its commercial success.

We conclude that there are genuine issues of material fact which must be determined at a trial and that the entry of summary judgment therefore was error.

The judgment of the district court will be reversed and the cause remanded for further proceedings.

McLAUGHLIN, *Circuit Judge,* dissenting.

In this patent case plaintiff sued defendant for infringement. Defendant moved for summary judgment on the ground that the patent is invalid and not infringed. It stated that "There is no genuine issue as to any fact material to disposition of this motion and defendant is believed entitled to judgment as a matter of law." Appellant agrees that in such situation summary judgment procedure is correct practice. See Allen-Bradley Co. v. Air Reduction Co., Inc., 391 F.2d 282 (3 Cir. 1968). Supporting its motion

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[21] Hygienic Specialties Co. v. H. G. Salzman, Inc., 302 F.2d 614, 617 (2 Cir. 1962); Thabet Manufacturing Co. v. Kool Vent Metal Awning Corp. of America, 226 F.2d 207, 212 (6 Cir. 1955); Application of Bartlett, 300 F.2d 942, 943-44 (C.C.P.A. 1962).

[22] See New York Belting & Packing Co. v. New Jersey Car Spring & Rubber Co., 137 U.S. 445, 450 (1890); Jacob Elishewitz & Sons Co., Inc. v. Bronston Brothers & Co., Inc., supra, n. 20. See also Graver Tank & Mfg. Co., Inc. v. Linde Air Products Co., 339 U.S. 605, 609 (1950); Bischoff v. Wethered, 76 U. S. 812 (1869).

re validity it presented the prior art cited by the Patent Office in the matter together with prior art not cited by said Office. Plaintiff in his brief opposing a finding in favor of the defendant on said motion made the following affirmative statement concerning the use of summary judgment in this particular instance.

"While summary judgment is a difficult remedy to obtain in a patent case, we are in accord with its application here. As a result of defense counsel's diligent research the Court has before it all of the necessary prior art to determine validity." The trial judge properly construing plaintiff's view as complete acceptance of the summary judgment procedure for determination of the base question as to the validity of the suit patent, proceeded to an exhaustive examination of the evidence thereon. His fundamental test for the granting of a design patent was that it "must be founded on invention of a new, original and ornamental design non-obvious to a person of ordinary skill in the art." That is the sound teaching of Judge Kalodner's opinion in R. M. Palmer Co. v. Luden's, Inc., 236 F.2d 496 (3 Cir. 1956) which states the basic law here involved. The single claim of appellant's patent consists of reference to the drawings of same which are the only descriptive specifications of the patent. After study of all the related prior art, which is presented at length in his opinion, the district judge concluded that the plaintiff merely combined elements which were all prior art; that plaintiff was most familiar with that prior art and by an ordinary designer's regrouping of it came up with this pool design. The whole evidence plainly justifies the court's holding.

Much of plaintiff-appellant's briefs are devoted to a labored effort at denying that he had flatly conceded that "the Court has before it all of the necessary prior art to determine validity" and that therefore he was in accord

with the use of the summary judgment procedure to so determine the all important question of validity of the patent. There is nothing now advanced in appellant's briefs from which can be inferred a genuine fact controversy regarding the patent's validity. The statutory presumption of validity is urged as a last resource but that falls as it should in the face of the impressive lack of the same statute's essentials for patentability. Clearly the appellant's pool design is not new; it shows no skill that rises to invention; compared to the prior art it fails in any original inventive ornamentation.

Appellant, in asserting his after-thought contentions, would now have it that the holding below is contrary to Graham v. John Deere Co., 383 U. S. 1 (1966). Actually, the district judge primarily relied upon that landmark decision for his findings in this appeal. In Graham, Mr. Justice Clark for the Court laid down the fundamental principle that:

> "While the ultimate question of patent validity is one of law, A. & P. Co. v. Supermarket Corp., supra, at 155, the § 103 condition, which is but one of three conditions, each of which must be satisfied, lends itself to several basic factual inquiries. Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined."

The trial judge meticulously followed the above guidelines. He passed upon all of the prior art and ascertained the differences between the latter and the Rains patent. He

resolved the level of ordinary skill in the pertinent art. Strictly observing the Graham requirements, he determined from all of the above that there were no non-obvious arrangements in the Rains pool, that there were no genuine facts at issue regarding the validity of the said patent. Appellant's deliberate attempted repudiation of his carefully considered conclusion in his brief to the district judge that there were no true questions of fact on the validity issue, glaringly reveals how right he was the first time when he admitted that there were no genuine questions of fact in the validity issue and that the latter was properly before the court on motion for summary judgment.

I would affirm the judgment of the District Court.

A True Copy:

Teste:

Clerk of the United States Court of Appeals
for the Third Circuit.

Constitutional Provisions, Statutes and Rules Involved

Constitution of the United States, Article I, Section 8 (1787):

Section 8. The Congress shall have Power * * *

* * *

To regulate Commerce with foreign Nations, and among the Several States, and with the Indian Tribes;

To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries;

Act of June 25, 1948; c. 646; 62 Stat. 928; *Title 28, United States Code, Section 1254:*

Section 1254. Courts of Appeals; certiorari; appeal; certified questions.

Cases in the Courts of Appeals may be reviewed by the Supreme Court by the following methods:

(1) By writ of certiorari granted upon the petition of any party to any civil or criminal case, before or after rendition of judgment or decree;

* * *

35 U. S. C. * * *

Section 103. Conditions for patentability; non-obvious subject matter.

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Constitutional Provisions, Statutes and Rules Involved.

Section 282. Presumption of validity—defenses.

A patent shall be presumed valid. Each claim of a patent (whether in independent or dependent form) shall be presumed valid independently of the validity of other claims; dependent claims shall be presumed valid even though dependent upon an invalid claim. The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting it.

Rules of the Supreme Court of the United States

PART V. JURISDICTION ON WRIT OF CERTIORARI

19.

CONSIDERATIONS GOVERNING REVIEW ON CERTIORARI

1. (b) Where a court of appeals has rendered a decision in conflict with the decision of another court of appeals on the same matter; or has decided an important state or territorial question in a way in conflict with applicable state or territorial law; or has deicded an important question of federal law which has not been, but should be, settled by this court; or has decided a federal question in a way in conflict with applicable decisions of this court; or has so far departed from the accepted and usual course of judicial proceedings, or so far sanctioned such a departure by a lower court, as to call for an exercise of this court's power of supervision.

United States Patent Office

Des. 201,793
Patented Aug. 3, 1965

201,793

SWIMMING POOL

John K. Raisz, 86 Trenton Ave., White Plains, N.Y.

Filed Apr. 26, 1963, Ser. No. 74,638
Term of patent 14 years
(Cl. D13—1)

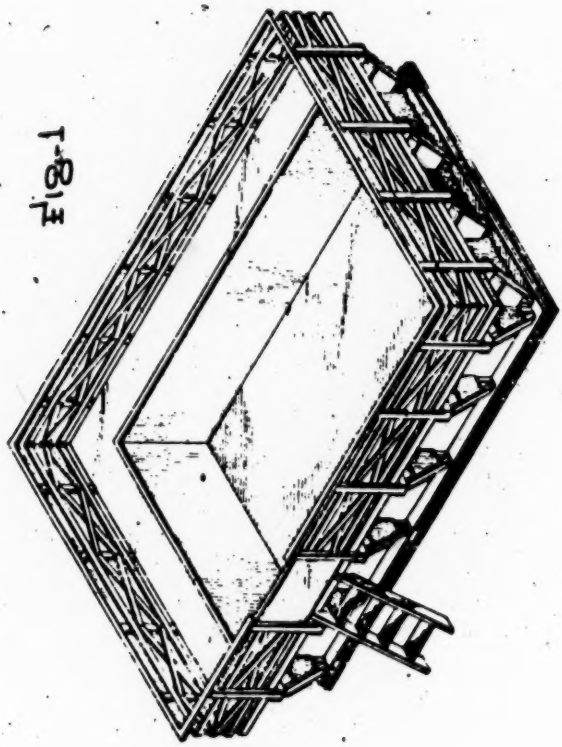


FIG. 1

A 36

FOR IDENT
D-2 IN EVID.
H. T. NOEL
OFFICIAL REPORTER
U. S. DISTRICT COURT

Top Quality

FUTURA FEATURES



256 SQ. FT. OF SWIMMING AREA... ACCOMMODATES UP TO 20 CHILDREN & ADULTS IN POOL AT ONE TIME

VELVET POOLSKIN ELIMINATES POOL PAINTING FOREVER

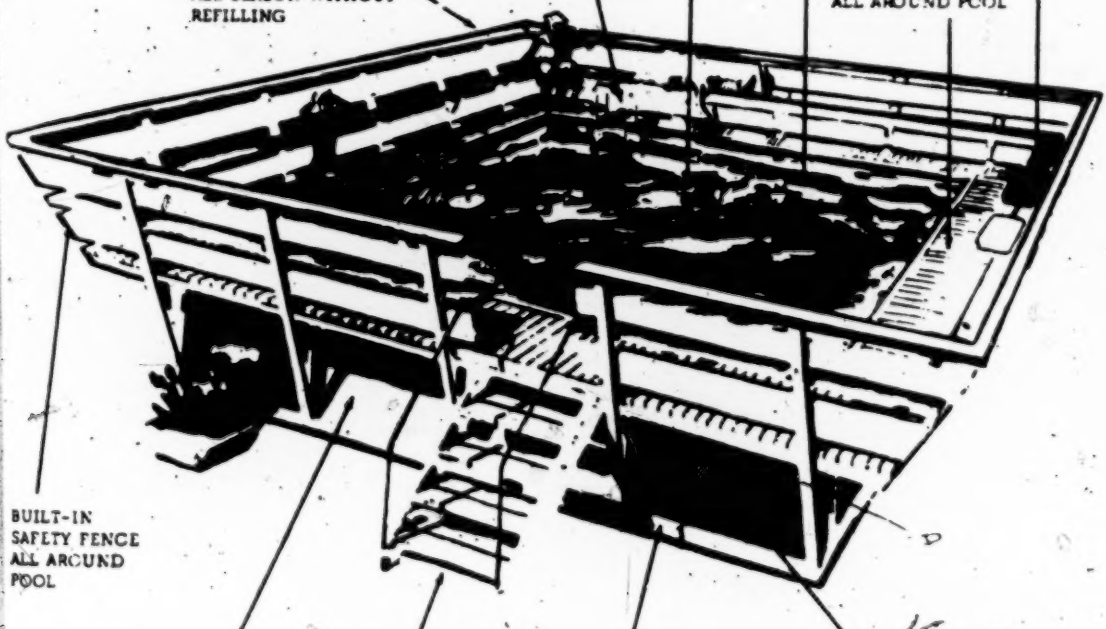
POOL LADDER

INLET AND OUTLET FEED THROUGH POOL LADDER LEGS ELIMINATES COSTLY PIPING

BUILT-IN BENCHES ENCIRCLING ALL 4 SIDES ... SPACE FOR 50 ADULTS

CIRCULATING FILTER UNIT USES SAME WATER ALL SEASON WITHOUT REFILLING

NON-SLIP REDWOOD DECK ALL AROUND POOL



BUILT-IN SAFETY FENCE ALL AROUND POOL

THICK EXTERIOR PLYWOOD PANELS GIVE EXTRA RIGIDITY

SAFETY STAIRWAY SWINGS UP AND LOCKS WHEN NOT IN USE

BRACED WITH STEEL TIE RODS FOR ENDURING STRENGTH

OUTSIDE PANELS CAN BE PAINTED TO SUIT YOUR CHOICE OF DECORATOR COLORS

CP11-A



Fig. 1.

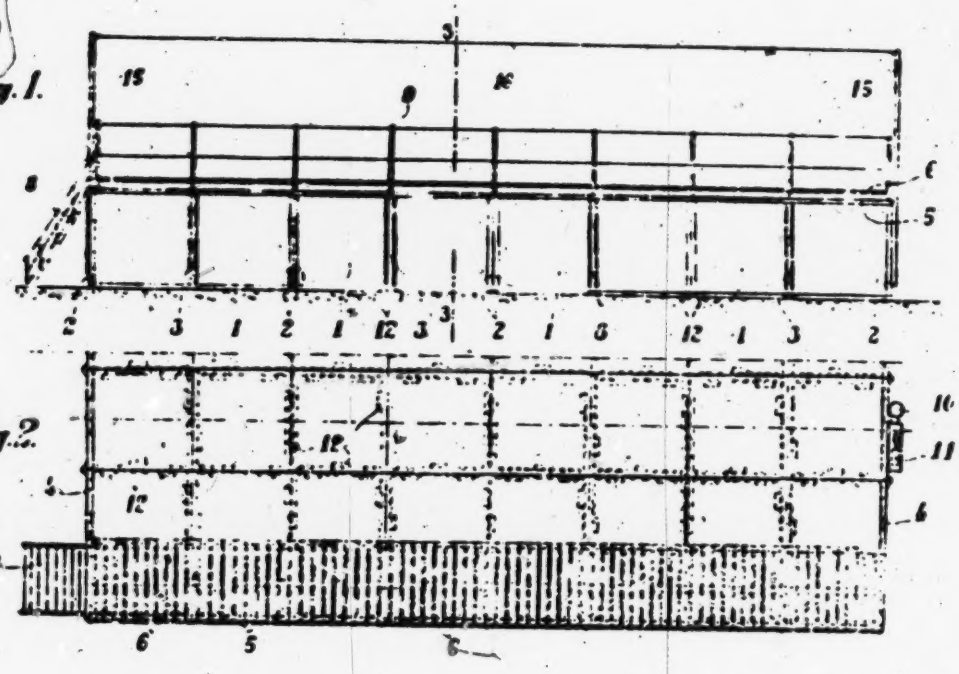


Fig. 2.

Fig. 3.

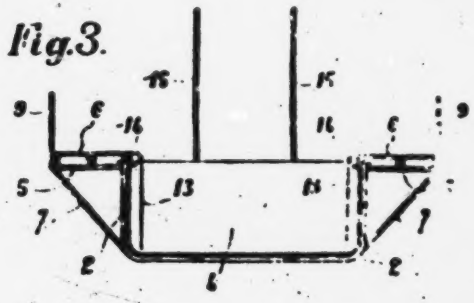
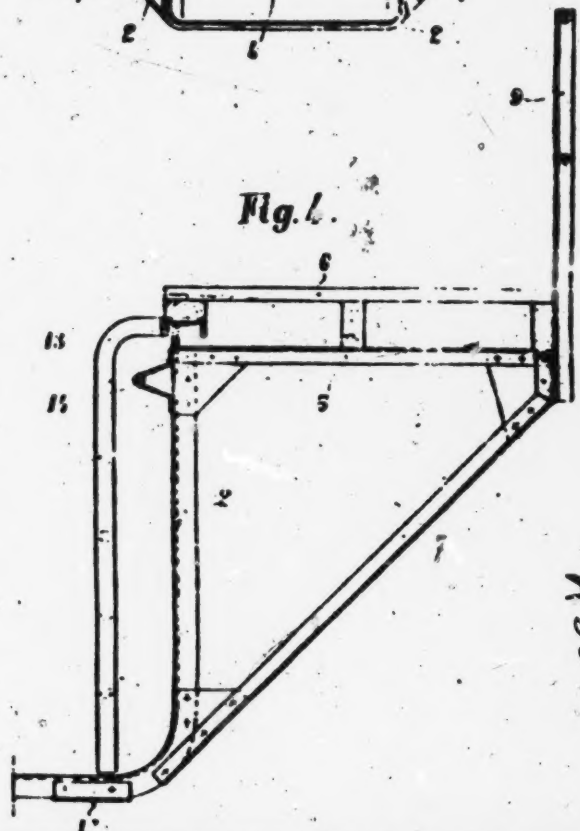
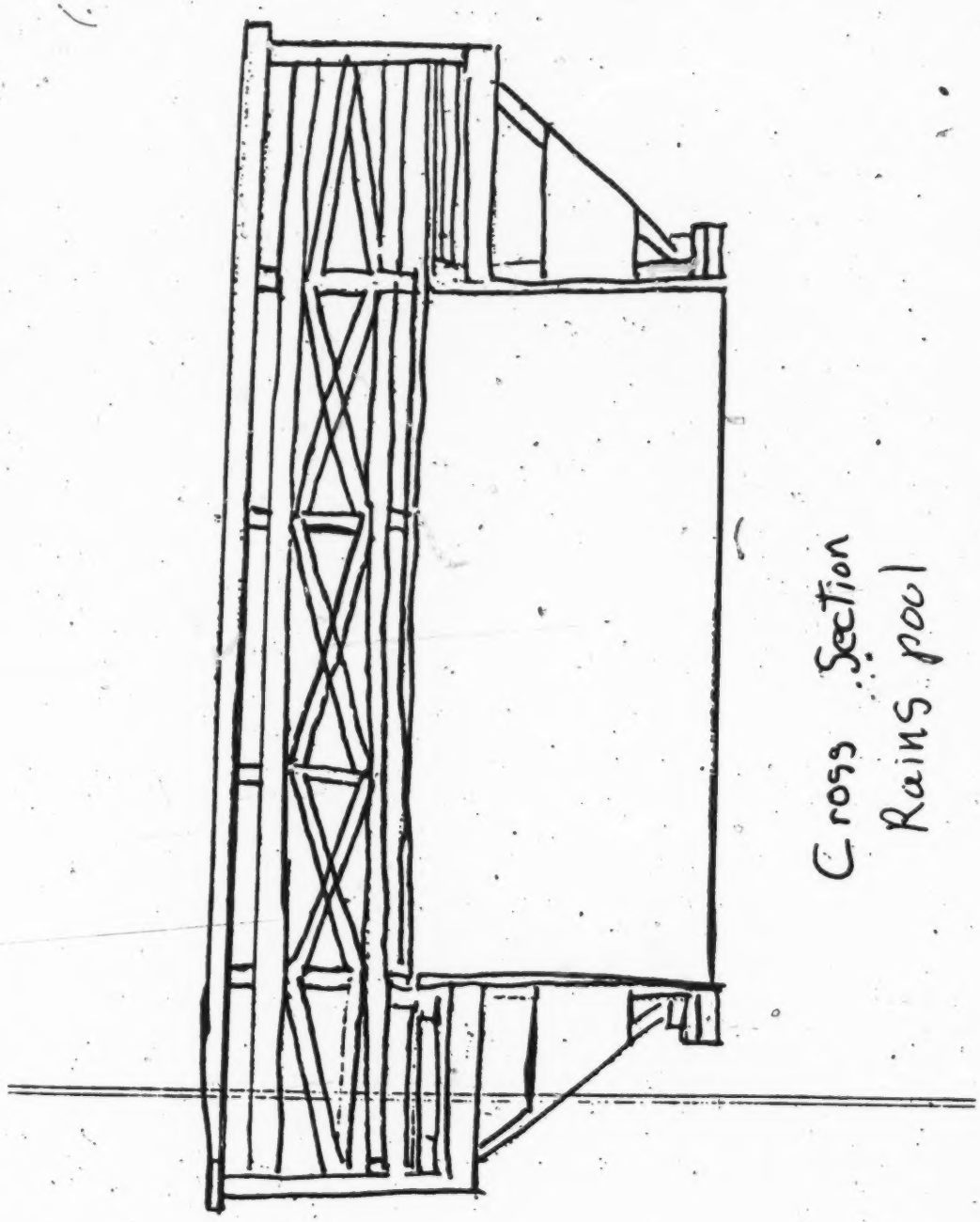


Fig. 4.



A38



Cross Section
Rains pool

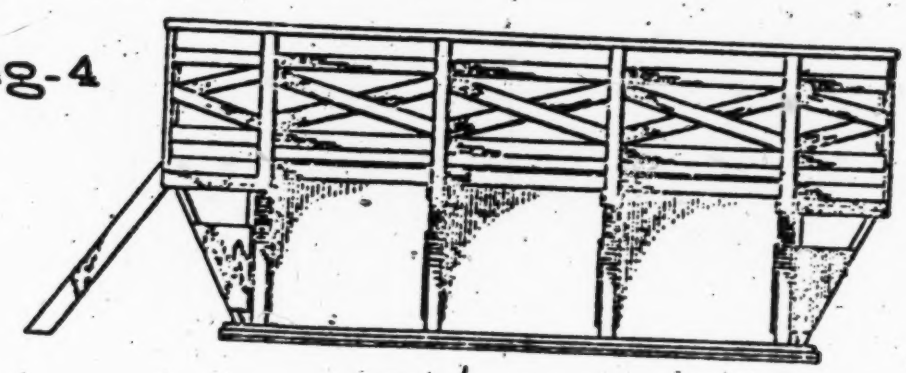
Fig-3

Rains



Side view

Fig-4



Endview

